

**REMARKS**

**Claim Rejections**

Claims 12-16 and 19-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi (US-6,199,122) in view of Estakhri et al. (US-6,182,162).

**Claim Amendments**

By this Amendment, Applicant has canceled claims 13 and 20, and amended claim 12. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Kobayashi discloses an external storage converter system including a reader/writer (12) including a serial interface (121), a conversion controller (122), a read only memory (123), an ATA controller (124), connectors (125), and removable memory cards (13) connected with connectors (125).

On page 3 of the outstanding Office Action, the Examiner admits that "Kobayashi does not expressly teach IDE interface." Kobayashi does not teach an IDE interface located on a circuit board and connecting the disk module to a main board of a computer; the IDE interface having an extending interface; nor does Kobayashi teach the power source is integrally formed with the IDE interface as a single connector.

The secondary reference to Estakhri et al. teaches a memory card desktop interface (100) including a housing (20) and a removable flash memory card (90). The housing includes a card slot (30) and a plug (50). The memory card (90) is connected to the desktop interface (100) by a plurality of contact pins (160) of a card receiver housing (130) connected to a jumper (140). The jumper (140) and the card receiver housing (130) are located on a bottom plate (110).

The secondary reference to Estakhri et al. do not teach an IDE interface located on a circuit board and connecting the disk module to a main board of a computer; an IDE interface having an extending interface; nor does Estakhri et al.

teach the power source is integrally formed with the IDE interface as a single connector.

Even if the teachings of Kobayashi and Estakhri et al. were combined, as suggested by the Examiner, the resultant combination does not suggest an IDE interface located on a circuit board and connecting the disk module to a main board of a computer; the IDE interface having an extending interface; nor does the combination suggest the power source is integrally formed with the IDE interface as a single connector.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

There is not the slightest suggestion in either Kobayashi or Estakhri et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Kobayashi, nor Estakhri et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious the amended claims.

**Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 13 and 20, thereby rendering moot the outstanding rejection of this claim under 35 U.S.C. § 103.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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